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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/998,847	11/15/2001	Hakchu Lee	10004123	6881

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AGILENT TECHNOLOGIES, INC.  
Legal Department, DL429  
Intellectual Property Administration  
P.O. Box 7599  
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EXAMINER

RAIZEN, DEBORAH A

ART UNIT PAPER NUMBER

2873

DATE MAILED: 07/29/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/998,847

Applicant(s)

LEE, HAKCHU

Examiner

Deborah A. Raizen

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 14 May 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 3-8 and 10-21 is/are pending in the application.
- 4a) Of the above claim(s) 3-8 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 16 is/are rejected.
- 7) ☒ Claim(s) 11, 12, 14, 15, 17-19 and 21 is/are objected to.
- 8) ☒ Claim(s) 3-8 and 10-21 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Election/Restrictions***

The restriction requirement made in paper #3 is repeated here to correct an error that the examiner made.

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 3-8 and 20 (claims 1 and 2 have been cancelled and claim 20 has been added), drawn to a grating-scale measurement system, classified in class 250, subclass 231.13 or class 356, subclass 499.
  - II. Claims 10-19 and 21 (claim 9 has been cancelled and claims 16-19 and 21 have been added), drawn to a telephoto lens, classified in class 359, subclass 708+.

The inventions are distinct each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because claim 1, which is directed to a combination of the type AB<sub>br</sub> (a grating scale measurement system in which a telephoto lens with aspheric lenses forms an image of a grating on a detector, which measures movement of an intensity distribution), does not set forth the details of the subcombination B<sub>sp</sub> claimed in Group II claims (subcombination B<sub>sp</sub> includes a

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finite conjugate subsystem of two aspheric lenses, followed by a magnifying system). Claim 1 therefore provides evidence that the combination of the measurement system as claimed does not require the particulars of the telephoto lens as claimed. The subcombination of the detailed telephoto lens has separate utility such as in a copy machine.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

In paper #3, examiner has erroneously indicated that claims 9-15 link inventions 1 and 2. Examiner further indicated that claims 10, 11, 13, and 14 are generic, and, accordingly withdrew the restriction requirement with respect to claims 3, 4, 6, and 7.

However, a subcombination claim is not generic to a combination claim (MPEP 806.04(c)). Therefore, the examiner erred in withdrawing the restriction requirement with respect to claims 3, 4, 6, and 7. If this error is not corrected, broader combination claims presented in a continuation or divisional application may be subject to provisional double patenting rejections. Therefore, the examiner repeats the original restriction requirement here and indicates that no claims are linking.

4. During a telephone conversation with Jack Wu on February 4, 2003, a provisional election was made without traverse to prosecute the invention of Group II, claims 9-15. At the time of the conversation, examiner had not indicated that any claims are linking. Affirmation of

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this election must be made by applicant in replying to this Office action. Claims 3-8 and 20 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention. This is not a new basis for rejection but only a withdrawal of claims from consideration on the basis of the election made without traverse.

### *Claim Objections*

1. Claims 11, 12, 14, 15, 17-19, and 21 are objected to because of the following informalities:

Claims 11, 12, 14, 15, and 17-19 are directed to "the lens of claim". Because more than one lens is recited in each of the base claims, the antecedent basis is not clear.

Claim 21 is directed to "the system of claim 10", but claim 10 is directed to a telephoto lens.

Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim 16 is rejected under 35 U.S.C. 102(b) as being anticipated by Ohno (6,362,924).

Ohno discloses a telephoto lens (Fig. 1, TELE, and Table 1, used in reverse) comprising: a first aspheric lens (L2: surface 4 is marked with a \*) and a second aspheric lens (L3: surface 5 is aspherical) positioned to form a subsystem (L2 and L3); and a magnifying system (L1)

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positioned to magnify an image of the subsystem (functional language, met when the Ohno telephoto lens is used in reverse), wherein the magnifying system comprises a first negative lens (L1), which has a negative focal length (Fig. 1 and Table 1).

***Allowable Subject Matter***

1. Claims 17-19 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

2. The following is a statement of reasons for the indication of allowable subject matter: The prior art taken either singularly or in combination fails to anticipate or fairly suggest the limitations of claims 17-19, in such a manner that a rejection under 35 U.S.C. 102 or 103 would be proper.

The prior art fails to teach a combination of all the features in claim 17. For example, these features include the detailed structure recited in claim 16 and also the additional feature of a second negative lens in the magnifying system.

The prior art fails to teach a combination of all the features in claim 18. For example, these features include the detailed structure recited in claim 16 and also the limitation that first and second aspheric lenses are substantially identical.

The prior art fails to teach a combination of all the features in claim 19. For example, these features include the detailed structure recited in claim 16 and also the limitation that the subsystem including the first and second aspheric lenses provides unit magnification.

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3. Claims 10-15 and 21 are allowed (except for the objection to the informalities in the dependent claims as explained above).

The following is an examiner's statement of reasons for allowance:

For reasons for allowance of claim 10, see paper #3.

For reasons for allowance of claim 13, see paper #3.

Claims 11, 12, and 21 depend on claim 10, and claims 14 and 15 depend on claim 13.

Claims 11, 12, 14, 15, and 21 are therefore will be allowed as well when the informalities are corrected.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah A. Raizen whose telephone number is (703) 305-7940. The examiner can normally be reached on Monday-Friday, from 8:30 a.m. to 5 p.m. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Georgia Y. Epps can be reached on (703) 308-4883. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9318 for regular communications and (703) 872-9319 for After Final communications.


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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-0956.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

dar  
July 22, 2003

  
Scott J. Sugarman  
Primary Examiner